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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Drennon/Castillo, Ltd.-I

Serial No. 75/185,834

William D. Jackson of Locke, Purnell, Rain, Harrell for
Drennon/Castillo, Ltd.

Kim Saito, Trademark Examining Attorney, Law Office 109
(Ron Sussman, Managing Attorney).

Before Simms, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Drennon/Castillo, Ltd.-I (applicant), a Texas limited
partnership doing business as Sierra Engineering, has
appealed from the final refusal of the Trademark Examining
Attorney to register the mark SIERRA ENGINEERING for the
following services:

on-site petroleum engineering services to
implement the treatment and stimulation of oil
and gas wells to enhance production, including
the design and the on-site supervision and
implementation of fracturing procedures by

hydraulic fracturing and well case perforating procedures by gun perforating.¹

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of two registrations, more fully discussed below. The Examining Attorney has also made final a requirement for a disclaimer for the word "ENGINEERING" apart from the mark as shown, as well as a final requirement for an acceptable identification of services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

Disclaimer

The Examining Attorney has required that applicant submit a disclaimer of the word "ENGINEERING." See Section 6 of the Trademark Act, 15 USC §1056, which requires the disclaimer of unregistrable components of a mark. The Examining Attorney argues that this word is merely descriptive of applicant's services in view of the fact that applicant offers petroleum engineering services. Applicant, on the other hand, contends that no disclaimer is necessary because its mark is a unitary one projecting a single commercial impression, and that:

¹ Application Serial No. 75/185,834, filed October 23, 1996, based upon dates of use of January 1, 1991.

The term "SIERRA" is subject to various connotations ranging from uses to indicate an irregular topological outline, to fish, to communications codes. The term "SIERRA" combines with the word "ENGINEERING" to create an incongruity. This results in a mark which indicates a thing which is essentially non-existent, or an incongruity which is necessarily unitary.

Applicant's brief, 11.

We fail to see the incongruity of which applicant speaks. Nor is the asserted mark a unitary one. In applicant's specimens of record (reproduced below), the word "SIERRA" is in a more prominent and different style of lettering than the word "ENGINEERING."

The requirement for a disclaimer of the descriptive word "ENGINEERING" is affirmed.

Description of Services

The Examining Attorney maintains that applicant's current description of services is unacceptable because it is indefinite and too broad. More particularly, the Examining Attorney argues that applicant's services could fall into several classes -- oil and gas well drilling in Class 37, oil well fracturing in Class 40, designing of new

treatment and stimulation techniques that would be encompassed by engineering services in Class 42.

...The applicant's recitation of services is confusing because of the use of the "on-site petroleum engineering services" prefatory language. While the applicant may be performing services that are in class 37 and 40, the inclusion of the "on-site petroleum engineering services" language would lead the people reading the recitation of services to conclude that the applicant also performs engineering services...

The recitation of services is indefinite because the applicant has used words such as "including"... in the recitation of services and the exact nature and extent of the applicant's services is unclear.

Examining Attorney's brief, 8-9.

Applicant, on the other hand, argues that its engineering services are properly classified in Class 40 (and not Class 42) and that they are otherwise sufficiently described. Applicant also argues:

Appellant's services, as are believed to be properly classified in Class 40, include the actual ongoing services involving the on-site supervision of oil and gas well treatment and stimulation services. While Appellant does not provide, for example, the services of an oil well service company in the sense of owning and providing equipment for hydraulic fracturing or gun perforating, Appellant's services do involve the actual stimulation of oil and gas wells. In this respect, Appellant's services involve the provision of petroleum engineers which actually function at the well site in the day-to-day activities involved in well stimulation, such as hydraulic fracturing. The description of the services emphasize[s] that Appellant's services involve on-site petroleum

engineering services in the day-to-day operation of supervising and implementing fracturing and completion activities. The excerpts from the Identification Manual appended to the Office Action of April 24, 1998... would appear to support classification of Appellant's mark in Class 40 as contrasted with Class 42.

Applicant's brief, 11-12.

We note that the Examining Attorney proposed the following description of services in her final refusal:

Class 40--oil and gas well fracturing by hydraulic fracturing; oil and gas well casing perforating procedures by gun perforating.
Class 42--petroleum engineering in the nature of design and supervision of fracturing procedures by hydraulic fracturing and well case perforating procedures by gun perforating for oil and gas wells.

After careful consideration of the arguments of the attorneys, and considering the expertise of the Examining Attorney in this matter, we believe that applicant's existing description of services is deficient because the services listed would appear to fall into at least two separate classes--oil and gas well hydraulic fracturing and gun perforating services in Class 40 and petroleum engineering services in Class 42. Accordingly, we affirm the Examining Attorney's requirement insofar as it requires a description of services which separate the services into services properly placed in Class 40 and petroleum engineering services in Class 42.

Likelihood of Confusion

The Examining Attorney has refused registration under Section 2(d), first, on the basis of Registration No. 1,185,205, issued January 5, 1982 (Sections 8 and 15 filed) for the mark SIERRA GEOPHYSICS for research and consulting services in geophysics and seismology. The registration issued pursuant to Section 2(f) of the Act, 15 USC §1052(f). The Examining Attorney argues that both applicant's mark and this registered mark are dominated by the primary origin-indicating word "SIERRA," and that the words "GEOPHYSICS" and "ENGINEERING" in the respective marks are of less significance in indicating origin and distinguishing the marks.

With respect to the services, the Examining Attorney requests that the Board take judicial notice of an excerpt from The Wiley Encyclopedia of Energy and the Environment, which notes that "The search for natural gas, the exploration, drilling and production expressly for natural gas, gained momentum after the advent of offshore exploration and benefited most from the recent advances in geophysics, particularly seismic work and data processing and electronic computing." The Examining Attorney argues that applicant's services in the petroleum field may overlap with registrant's research and consulting services

in geophysics and seismology because both services involve or may use geophysics. That is to say, according to the Examining Attorney, geophysical and seismological studies may be used in connection with petroleum engineering and in the performance of a fracturing operation or perforating of a well casing for oil and gas wells. The Examining Attorney points out that applicant has admitted that seismic surveys may be useful in identifying oil fields. In this regard, the Examining Attorney points to Nexis excerpts of record noting the fact that petroleum engineering and geophysics may be related endeavors in the exploration for oil and that seismology is used in the discovery of gas deposits. The Examining Attorney has also made of record third-party registrations covering oil drilling and geophysical exploration services and others covering engineering and consulting and research in geophysics.

Applicant, on the other hand, argues that geophysical services such as seismic surveys may be used to explore for a variety of minerals not relating to the oil or gas well drilling industry. Applicant argues that geophysics is useful in the mining industry and not necessarily in oil and gas production. According to applicant, the fact that geophysics or seismic exploration may lead to the

identification of geological structures suitable for drilling does not mean that those services are related or that they would travel in the same channels of trade. Finally, applicant argues that the respective services would be purchased by sophisticated purchasers after careful consideration of the experience and reputation of the provider of those services.

With respect to the marks, applicant maintains that "SIERRA" is a common word in numerous marks and that there have been no instances of actual confusion.²

Concerning the marks, we agree with the Examining Attorney that each is dominated by the word "SIERRA," the remaining word being descriptive or generic and of relatively little source indication.

² In her brief, the Examining Attorney for the first time objected to the third-party registrations which applicant attempted to make of record in response to the initial refusal of registration. The Examining Attorney argues that the results of a trademark search report may not be relied upon, but rather any third-party registrations may be made of record by making copies of the registrations themselves of record or the electronic equivalent thereof, that is, printouts of the registrations from the electronic records of the Patent and Trademark Office's automated search system. It is not a good practice to ignore and/or fail to timely object to evidence when a timely objection may well have allowed applicant to have cured any deficiency noted by the Examining Attorney. In any event, we agree with the Examining Attorney that the subsisting registrations referred to by applicant are for goods, such as firefighting equipment, roofing and construction materials, wood paneling, windows, etc., which are unrelated to applicant's and registrant's services. Accordingly, we have given the registrations very little weight.

With respect to the services, the question is whether applicant's and registrant's services are related in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from the same source, in view of the similarity of the marks. We believe that this record is sufficient to show a substantial relatedness between registrant's research and consulting services in geophysics and seismology and applicant's petroleum engineering and oil and gas well services. While these services are unquestionably specifically different, they are nevertheless related in the sense that registrant's services may be used in the exploration for oil and gas, and that applicant's services are useful in the production of oil and gas. A purchaser, even a relatively sophisticated one in the oil and gas industry, aware of registrant's SIERRA GEOPHYSICS services, who then encounters applicant's SIERRA ENGINEERING petroleum engineering and oil and gas well services is likely to believe that those services are related in the sense that they come from the same source or are sponsored by the same entity. Finally, if we had any doubt about this matter,

this doubt should be resolved, as the Examining Attorney points out, in favor of the prior user and registrant.

With respect to the other registration, Registration No. 1,802,340, issued November 2, 1993, that registration issued for the mark shown below.



The words "ENVIRONMENTAL SERVICES" are disclaimed. The registration issued for "environmental cleanup services; namely, ground water treatment, soil remediation, analytical chemical services, preliminary site assessments, and consulting services related thereto." While the Examining Attorney argues that environmental cleanup services are sometimes used in connection with oil and gas wells, we believe that applicant's engineering/oil and gas well services are sufficiently different from, and only

possibly tangentially related to, registrant's environmental cleanup services (which do not specifically pertain to the cleanup of oil spills), that confusion is unlikely.³

Decision: The refusal of registration in view of Registration No. 1,185,205 is affirmed. The refusal of registration with respect to Registration No. 1,802,340 is reversed. The requirements with respect to the disclaimer and identification of services are affirmed, as indicated above.

R. L. Simms

G. D. Hohein

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

³ While this cited registration has not been cancelled pursuant to Section 8 of the Act, Office records, as of this date, show no filing of any Section 8 affidavit, the last date for filing of which would have been May 2, 2000.